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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,517	10/24/2003	Bernard J. Patsky	UTL 03-032	9868

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JAMES F. BAIRD, ESQUIRE
33 East Main Street
P.O. Box 574
West Brookfield, MA 01585-0574

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,517

Applicant(s)

PATSKY, BERNARD J.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,6-16 and 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 8/13/04
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-2, and 15-16, drawn to a method of locating parallax corrected sweet spot target line, classified in class 473, subclass 409.
 - II. Claims 3-5, and 17, drawn to a club with parallax corrected target line, classified in class 473, subclass 292.
 - III. Claims 6-8, drawn to method to locate a face line on a top head without a grip or shaft, classified in class 473, subclass 409.
 - IV. Claims 9-14, drawn to a club with face line on top surface, classified in class 473, subclass 251-255.
 - V. Claims 18-19 and 23-24, drawn to a method of forming a sweet line, classified in class 473, subclass 409
 - VI. Claims 20-22, drawn to a tool, classified in class 473, subclass 408.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions a method of locating parallax corrected sweet spot target line and a club with parallax corrected target line are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as

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claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the club can be practiced by a different process as one without locating an incorrect target line.

4. Inventions a method of locating parallax corrected sweet spot target line and a club with face line on top surface are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case a club having face line on a top surface does not need to have the method of locating a parallax corrected sweet spot.

5. Inventions a method of locating parallax corrected sweet spot target line and a tool are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case a the method of locating parallax corrected sweet spot target line does not require the new tool.

6. Inventions a method of locating parallax corrected sweet spot target line and a method of forming a sweet line are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each method can be used independently so locate a sweet line or a parallax corrected sweet spot target line. See MPEP § 806.05(d).

7. Inventions a method of locating parallax corrected sweet spot target line and a method of forming a sweet line are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each method can be used independently so locate a sweet line or a parallax corrected sweet spot target line. See MPEP § 806.05(d).

8. Inventions of a club with parallax corrected target line and a club with face line on top surface are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, a parallax correction is not needed with a face line on a top surface and a face line is not needed with a parallax correction. See MPEP § 806.05(d).

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

10. This application contains claims directed to the following patentably distinct species of the claimed invention for group V claims.

Type of tool used in the method

- a. Species 1 (Donut): Claims 18-19.
- b. Species 2 (ball and rod): Claims 23-24.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

11. During a telephone conversation with Mr. James Baird on 13 August 2004 a provisional election was made without traverse to prosecute the invention of a club with parallax corrected target line, claims 3-5 and 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-2, 6-16, and 18-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "may" in 5d is indefinite. It is uncertain if the function being referred is able to be performed or not.

Content of Specification

14. The title is too long. It preferably should be two to seven words (See 37 CFR 1.72(a) and MPEP § 606).

Specification

15. The disclosure is objected to because of the following informalities:

a. On page BDD 2 of 11 line 14 the word "Righ" is misspelled.

Appropriate correction is required.

b. On page BDD 4 of 11 lines 17-18 the statement "The following portion of the Brief Description of the Drawings has been added to the Brief Description of the Drawings submitted with Application 09/797,357." Appear to be personal notes and should be removed.

c. There are not Brief Description of the Drawings for figures 45A and 45B.

d. On page BDD 11 of 11 lines 13-15 there are two different names for reference number 107.

16. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 3-5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan in view of Jessen and Kobayashi.

Ryan discloses a golf club with a parallax corrected (abstract, Col. 1, Lns. 19-25, 29-35) sweet spot target line markings, a marking extending from a point at the intersection of the face surface and the top surface (Fig. 5), and lines showing non-corrected target lines and corrected lines (Figs. 2, 3, 5).

Ryan lacks a grip, an increased width line on a top surface ending at a point at the intersection of the top surface with the bottom surface and center of gravity located behind a sweet spot. Jessen discloses a golf club having a grip (Fig. 2) and broad line on a top surface (Fig. 6). Kobayashi discloses a head having a top surface intersection in a rear of a head with a bottom surface (Fig. 2) and center of gravity located behind a sweet spot (Col. 2, Lns. 44-53) in order to increase distance of flight of a ball with improved directing performance (Col. 2, Lns. 59-62). In view of the patent of Jessen it would have been obvious to modify the golf club of Ryan to have a grip in order to minimize the vibrations felt by a player. In view of the patent of Jessen it would have

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been obvious to modify the golf club of Ryan to have increased width lines on a top surface ending at a back end of a top surface showing corrected and non-corrected target lines in order to utilize a parallax corrected line instead of an arrow marking to assist a player in properly aiming a head who prefers a line while playing a round of golf. In view of the patent of Kobayashi it would have been obvious to modify the head of Ryan to have a top surface intersect with a bottom surface in order to use the advantages of parallax correction for an alignment of a club for a head which has a bottom surface which intersects with a top surface at a rear end. As such a line on a top surface would end at a point at the intersection of the top surface with the bottom surface. In view of the patent of Kobayashi it would have been obvious to modify the head of Ryan to have a center of gravity located behind a sweet spot in order to increase distance of flight of a ball with improved directing performance.

With respect to claims 4-5 and 17, very little weight is given to the method steps of how the parallax corrected target line is made on the head since this is an apparatus claim and not a method claim. Weight is give to what an apparatus is and not how it is made. The club due to the combination of Ryan in view of Jessen and Kobayashi is the same product as that claimed in claims 4-5 and 17.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712.

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The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 17 August 2004



STEPHEN BLAU
PRIMARY EXAMINER